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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,392	08/20/2004	Peter J Dronzek JR.	181-037	7246
47888 7590 11/14/2008 HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/505,392

**Applicant(s)**

DRONZEK ET AL.

**Examiner**

VICTOR S. CHANG

**Art Unit**

1794

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-6 and 8-53 is/are pending in the application.
- 4a) Of the above claim(s) 12-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date 9/2/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' amendments and remarks filed on 9/10/2008 have been entered. Claim 1 has been amended. Claims 1, 3-6 and 8-11 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendment, the grounds of rejection have been rewritten as set forth below.

### ***Rejections Based on Prior Art***

4. Claims 1, 3-6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer [US 6328340] in view of Caputo et al. [US 4840270].

Fischer's invention relates to a form having a detachable card. Fig. 1 shows a form sheet 1 of paper and a piece of a substrate material 2. The substrate 2 further comprises a substrate layer 21 (layer (iv) of the claimed invention), a peeling adhesive layer 22, an outer layer 23 (layer (iii) of the claimed invention), and a permanent pressure-sensitive adhesive layer 24. The substrate 2 is adhered to the lower surface of form 1 by means of the permanent pressure-

sensitive adhesive layer 24. A piece of a covering material 4, which comprises an outer layer 41 and a permanent pressure-sensitive adhesive layer 42, is provided on the front of the form. The outer layers 23 and 41 are transparent plastic films, such as polyester films [col. 4, lines 46-57]. A punching (die cut) runs all the way through the layers 41, 42, 1, 24, 23 and 22 and reaching down as far as the substrate layer 21 [col. 4, line 62 through col. 5, line 5]. During detaching of the card 3, the peeling adhesive 22 is completely detached from the substrate layer 21 and stays with the card. The peeling adhesive layer 22 has a non-permanent adhesive effect with respect to the substrate 21 and a permanent adhesive effect with respect to the outer layer 23 [col. 5, lines 12-16]. The different adhesive effects with respect to the substrate layer 21 and the outer layer 23 can be achieved by a suitable process control and/or different pretreatment of the surfaces of the layers 21 and 23 [col. 3, lines 28-36]. The detachment from the substrate material 21 has caused layer 22 to lose its stickiness, so that the card 3 is not self-adhesive, and the no longer sticky peeling adhesive layer can be written or printed [col. 5, lines 19-22].

For claims 1, 5 and 8-11, Fischer teaches all the claimed features, except being silent about 1) the surface treatments on the upper surface of substrate layer 21 (layer (iv) of the claimed invention) and lower surface of outer layer 23 (layer (iii) of the claimed invention) are characterized by differential treatment patterns of treated area and non-treated area, 2) the percentage of treated area. However, regarding item 1), Caputo's invention relates to a resealable label flap. Fig.1 illustrates that a selected zone of a surface has been corona treated (differentially treated). The pressure sensitive label-flap is adhered to both untreated and a circular corona treated area (a closed curve). The thermoplastic surface treated with a corona discharge provides a surface for a stronger bond between to the pressure sensitive adhesive and

the remaining untreated surface provides a weaker bond with the same pressure sensitive adhesive. Since Fischer teaches that the different adhesive effects with respect to the substrate layer 21 and the outer layer 23 can be achieved by a suitable process control and/or different pretreatment of the surfaces of the layers 21 and 23, it would have been obvious to one of ordinary skill in the art of surface treatment to select Caputo's differential treatment pattern to obtain the required level of adhesion, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding item 2), since Caputo shows the differentially treated structure effects the releasability of the adhesive to the label flap, a workable percentage of treated area over the surface to achieve the required adhesiveness is deemed to be an obvious routine optimization to one skilled in the art, motivated by the desire to obtain the required adhesiveness dictated by the same end use. Regarding the terms "pattern" and "alternating areas of easy and tight separation", since Caputo teaches a selected zone of a surfaced has been corona treated, it is interpreted as inherently has a pattern of corona treated area, and the treated and untreated area reads on the limitation "alternating areas of easy and tight separation". Regarding newly added process limitation "wherein the card is provided with formed by a die cut", it is anticipated by Fischer's teaching of "a punching (die cut) runs all the way through the layers 41, 42, 1, 24, 23 and 22 and reaching down as far as the substrate layer 21", as set forth above.

For claims 3 and 4, Fischer is silent about the thickness of polyester film layer and the weight basis of the paper stock. However, since Fischer teaches the generally same subject matter for the same use (detachable card intermediate) as the instant invention, a workable thickness of polyester film and weight basis of paper stock are deemed to be either anticipated by

Fischer, or obvious routine optimizations to one skilled in the art of detachable card intermediate, motivated to obtain required card physical properties for the same use.

For claim 6, Fischer is silent about the amount of difference in adhesion. However, since Fischer teaches the generally same subject matter for the same use as the instant invention, a workable difference in adhesion for achieving different adhesive effects is deemed to be either anticipated by Fischer, or obvious routine optimizations to one skilled in the art of detachable card intermediate, motivated to easily detach the card for the same use.

### ***Response to Argument***

5. Applicants argue at Remarks page 13 that

“When the Fischer device is constructed, the peelable adhesive is transferred to the card as the card is removed. This peelable adhesive will cause the removed card to stick to other cards which is a distinct disadvantage.”

However, applicants’ argument contradicts Fischer’s teaching that the detachment from the substrate material 21 has caused layer 22 to lose its stickiness, so that the card 3 is not self-adhesive, and the no longer sticky peeling adhesive layer can be written or printed.

Applicants’ arguments at pages 13-14 directed to Fischer and Caputo individually ignore that the grounds of rejections are based on the collective teachings of prior art as set forth above.

Applicants argue at pages 14-15 that

“The Examiner has stated that since Caputo relates to the control of adhesive effects and Fischer teaches that different adhesive effects can be achieved through suitable process control. Claim 1 does not use process controls to control adhesion; the use of discrete areas having different adhesion are not suggested by any method of controlling the overall adhesion of a continuous layer. The references are not properly combinable based on the teachings found in the references. The Caputo patent has been applied for the limited purpose of its teaching of the corona treatment method of modifying adhesion which does not make obvious the differential pattern as defined in amended claim 1. The

differential method of Caputo is to completely treat the area where the flap is to be anchored as no other treatment is applied at that location. The language of claim 1 of the present application requires a patterned treated area to be formed that extends under card area defined by the diecut. Thus, Caputo's "differential treatment" is concentrated at one location for the purpose of providing a permanent anchorage for the flap 14. There is not the slightest suggestion that a pattern of variable adhesion is to be formed under an area where a card is positioned in order to make the card removable."

However, Caputo's differential treatment relates to a selected zone of a surfaced has been corona treated. The entire area including untreated area is interpreted as a pattern, which contains "alternating areas of easy and tight separation". It should be noted that the limitation a pattern of variable or alternating adhesion does not require the presence of a repeated pattern, and fails to exclude the pattern taught by Caputo.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794